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Paper No. 6

In re Application of
Pan, et al.
Application No. 09/682,685
Filed: October 5, 2001
Attorney Docket No. GEMS8081.099

DECISION ON PETITION

In re Application of
Pan, et al.
Application No. 10/042,724
Filed: February 28, 2002
Title: System and Method of
Imaging Using a Variable Speed
For Thorax Imaging

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OFFICE OF PETITIONS

This is a decision on the "Petition for Leave to File a Substitute Patent Application Under 37 CFR §§1.53(e), 1.182 and 1.183," filed February 28, 2002 and "Supplement to Petition" filed March 13, 2002. This also responds to a prior "Petition for Refund" and a "Request for Corrected Filing Receipt" both filed January 29, 2002.

On October 5, 2001, at 11:30:35 EDT¹, petitioner electronically filed the subject patent application entitled "System and Method of Imaging Using a Variable Speed Table for Thorax Imaging." At 12:10:19 EDT, petitioner electronically filed a patent application entitled "Efficient Multi-Slice Acquisition with Black Blood Contrast in Fast Spin Echo Imaging." Petitioner states that, on February 26, 2002, he was contacted by Official(s) at the USPTO Electronic Business Center who informed him of the double-filing of the patent application; the same specification, claims and drawings had been filed in both applications. In response, petitioner promptly filed the instant petition.

Relevant Statutes, Regulations and Rules

35 U.S.C. 111(a)(4) provides, in reference to nonprovisional applications, that:

The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

The procedure for filing a nonprovisional application is set forth at 37 CFR 1.53(b). This section states in pertinent part that:

¹ Eastern Daylight Savings Time.

The filing date of an application for patent filed under this section, except ..., is the date on which a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to §1.71 and at least one claim pursuant to §1.75, and any drawing required by §1.81(a) are filed in the Patent and Trademark Office. No new matter may be introduced into an application after its filing date.

(Emphasis added)

Moreover, §1.53(e) provides for certain failures to meet filing date requirements, as follows:

- (1) If an application deposited under paragraph (b), (c), or (d) of this section does not meet the requirements of such paragraph to be entitled to a filing date, applicant will be so notified, if a correspondence address has been provided, and given a time period within which to correct the filing error.
- (2) Any request for review of a notification pursuant to paragraph (e)(1) of this section, or a notification that the original application papers lack a portion of the specification or drawing(s), must be by way of a petition pursuant to this paragraph accompanied by the fee set forth in §1.17(h). In the absence of a timely (§1.181(f)) petition pursuant to this paragraph, the filing date of an application in which the applicant was notified of a filing error pursuant to paragraph (e)(1) of this section will be the date the filing error is corrected.
- (3) If an applicant is notified of a filing error pursuant to paragraph (e)(1) of this section, but fails to correct the filing error within the given time period or otherwise timely (§1.181(f)) take action pursuant to this paragraph, proceedings in the application will be considered terminated. Where proceedings in an application are terminated pursuant to this paragraph, the application may be disposed of, and any filing fees, less the handling fee set forth in §1.21(n), will be refunded.

Whereas, §1.183 provides that:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in §1.17(h).

(Emphasis added)

Additionally, § 1.182 provides that:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of

the Commissioner, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in §1.17(h).

37 CFR 1.26(a):

The Commissioner may refund any fee paid by mistake or in excess of that required. A change in purpose after the payment of a fee, such as when a party desires to withdraw a patent or trademark filing for which the fee was paid, including an application, an appeal or a request for oral hearing, will not entitle a party to refund of such fee.

MPEP §503 provides that:

Applications which are entitled to a filing date and are filed, whether by regular mail or "Express Mail" under 37 CFR 1.10, by hand-delivery or otherwise, will not be returned to applicant even if requested. See 37 CFR 1.59. Accordingly, applicants must be careful not to file applications which are not intended to be filed, e.g., duplicates of applications already filed. Since 37 CFR 1.26(a) precludes refund of an application filing fee when applicant desires to withdraw an application, any request by applicant not to process or charge an application filing fee because the application was not intended to be filed must be in the form of a petition under 37 CFR 1.183 requesting suspension of the rules to the extent that the filing fee not be processed or charged. Any such petition must include the fee set forth in 37 CFR 1.17(h) and must be accompanied by an express abandonment of the application in accordance with 37 CFR 1.138. In order for such a petition to be granted, it must ordinarily be filed and acted upon prior to the date on which the application filing fee is processed or charged by the Office with regard to the application.

DISCUSSION

Petitioner acknowledges, albeit mistakenly, submitting the application entitled "Efficient Multi-Slice Acquisition with Black Blood Contrast in Fast Spin Echo Imaging" for both of the above referenced EPAVE submissions, resulting in Serial No. 09/682,685 ('685) being assigned to the first submitted application and Serial No. 09/682,687('687) being assigned to the second submitted application. Petitioner does not dispute that the papers applicant intended to be filed as application No. '685, the same papers that constitute the substitute patent applicant filed February 28, 2002, were not among the papers present in the application as filed on October 5, 2001. Petitioner does not argue that these papers were "present" in the application via a proper incorporation by reference, or by any other means.

Rather, petitioner, in essence, requests that the filing error be excused and he be allowed to later present the papers intended to have been filed on October 5, 2001, and retain a filing date of October 5, 2001. Petitioner recognizes the right to expressly abandon the mistakenly filed application No. '685 and accordingly file the appropriate application anew. However, expressly abandoning application No. '685 and refileing the appropriate

application would result in a loss of the October 5, 2001 filing date. As a result, petitioner may be jeopardized by an intervening art that may have a detrimental effect on the patentability of petitioner's invention. Additionally, refiling of the application would require a repayment of the filing fees originally paid on October 5, 2001.

Petitioner respectfully believes that the facts set forth herein describe an extraordinary situation that as a matter of justice justifies a waiver of the regulations. Petitioner clearly intended to file two separate and distinct patent applications on October 5, 2001. Regrettably, the same application was included in both EPAVE submissions and filed with the USPTO, yet, the transmittals, attorney docket numbers, and declarations identify two separate and distinct applications.

Petitioner contends that such a clerical error would not have occurred had the applications been filed through the traditional Express Mail system since hard copies are easily reviewable, and the undersigned's office policy is to have the filing attorney review all documents before insertion into the Express Mail envelope. While the Petitioner and its attorneys have adopted the PTO's electronic filing initiative, errors can occur, and petitioner does not believe that a clerical error in e-filing of a patent application should result in a loss of rights under this scenario.

Therefore, petitioner respectfully requests leave to file a substitute patent application and accordingly, replace the earlier filed application with the substitute patent application that was originally intended to be filed without a loss of the filing date or serial number originally accorded the first October 5, 2001 submission. Petitioner believes that C.F.R. §1.183 allows such leave to prevent an unintentional loss of petitioner's rights.

ANALYSIS

The application papers filed October 5, 2001, presently assigned serial No. '685, included a specification, claims and drawings, and thus, were properly accorded a filing date of October 5, 2001. No matter an applicant's intention, application papers not shown to have been present in this application on the filing date cannot be considered a part of the original disclosure of this application. As it is undisputed that the papers constituting the substitute patent application filed February 28, 2002, were not present in the Office on October 5, 2001, the application cannot be accorded the October 5, 2001 filing date with these papers as a part of the original application disclosure.

Moreover, applicant cannot make these papers a part of the application disclosure by filing a substitute application. First, of all, the application papers filed February 28, 2002, are not within the meaning of the term a "substitute" application of application No. 09/682,685. These papers are not a duplicate of the papers filed October 5, 2001. It is further noted that

even if they were they would not be entitled to the earlier filing date".

More importantly, an applicant may not introduce new matter into an application after its filing date. Although an applicant may submit a substitute specification or substitute drawings to correct informalities (i.e., MPEP 1.125), these substitutes will be denied entry to the extent they contain new matter. It is clear that the entirely new specification, claims and drawings applicant seeks to enter into application No. 09/682,685 are new matter. In fact, petitioner does not contend that the subject matter of the substitute application papers is not new matter.

The requirement that the filing date of an application be the date of receipt of the specification, including at least one claim and any required drawing is a requirement of the statutes and cannot be waived. Additionally, the statutory provision, 35 U.S.C. 132, also provides that no amendment shall add new matter into an invention, and cannot be waived.

Even if these requirements could be waived, an error, such as when a party attempting to file an application makes an avoidable mistake when depositing the papers, will not be considered an extraordinary circumstance warranting waiver of the regulations under §1.183. Likewise, such a situation, does not merit suspension of the rules. Section 22 of title 35 of the United States Code expressly provides for electronic filing of documents. However, this specific filing error is not provided for in the regulations. Yet, no regulation can be suspended in a manner that contravenes the statutes (i.e., to in effect allow the Commissioner to waive statutory requirements).

Furthermore, pursuant to MPEP §503, the application as filed on October 5, 2001 was entitled to a filing date and will not be returned to applicant even if requested. See 37 CFR 1.59. The fact that the error occurred in electronically filing this application does not change this conclusion. Additionally, petitioner's request comes after the processing of the fee on October 9, 2001, is not accompanied by a petition under §1.183, and does not include an express abandonment. Thus, 37 CFR 1.26(a) precludes refund of the application filing fee.

201.09 Substitute Application

The use of the term "Substitute" to designate any application which is in essence the duplicate of an application by the same applicant abandoned before the filing of the later application, finds official recognition in the decision *Ex parte Komenak*, 1940 C.D. 1, 512 O.G. 739 (Comm'r Pat. 1940). Current practice does not require applicant to insert in the specification reference to the earlier application; however, attention should be called to the earlier application. The notation on the file wrapper (see MPEP § 202.02) that one application is a "Substitute" for another is printed in the heading of the patent copies. See MPEP § 202.02. As is explained in MPEP § 201.11, a "Substitute" does not obtain the benefit of the filing date of the prior application. Use form paragraph 2.07 to remind applicant of possible substitute status.

CONCLUSION

The request to file a substitute patent application, which is being treated as a request to retain the original filing date of October 5, 2001, but to enter a new specification, claims and drawings as the original application disclosure, is DISMISSED.

The request for refund of claim fees is DENIED³.

The application papers filed February 28, 2002, have been removed from the file jacket of application No. 09/682,685, placed in their own file jacket and assigned application No. 10/042,724.

Application No. 09/682,685 is being returned to the examiner for examination in due course, absent the filing of an express abandonment.

Application No. 10/042,724 is being forwarded to the Office of Initial Patent Examination for preexamination processing with a filing date of February 28, 2002. All future correspondence concerning this application should be directed to application No. 10/042,724. (An IDS was filed June 26, 2002 and made of record in application No. 09/682,685).

Telephone inquiries related to this decision may be directed to Petitions Attorney Nancy Johnson at 703-305-0309.


Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

³ The Office mailed to applicant a letter dated July 25, 2002 specifically denying the refund request in the amount of \$138.